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10/006,530	12/05/2001	Naoto Akimoto	1232-4792	1342
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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER MENBERU, BENIYAM	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/006,530	Applicant(s) AKIMOTO ET AL.	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed November 5, 2007 have been fully considered but they are not persuasive. Applicant stated in the Remarks on page 10, first full paragraph, that U.S. Patent No. 6157706 to Rachelson (Rachelson '706) does not disclose generating an attachment based on the received facsimile data. However Examiner disagrees since as stated previously that in Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU Attachment". Further this goes as output of SMTP server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10, lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments are processed for incoming emails which are converted to facsimile data. Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 20 recites the limitation "said transmission" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 7, 8, 10, 13, 16, 17, 18, 19 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al.

Regarding claim 1, Rachelson discloses a communication apparatus comprising:
registration means for registering an electronic mail account of a client via a first network upon receiving a request from the client (column 8, lines 3-15; The address

book is the registration means. The request occurs when e-mail is received from someone the first time.), wherein the request includes a customized format of an image to be received (column 10, lines 21-31; see "recipient preferences" ; column 11, lines 21-29; Figure 2, the administrator 100 communicates over Internet);

reception means for receiving facsimile data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2;);

confirming means for confirming whether the client maintains a valid account (column 11, lines 12-18; column 8, lines 21-27);

generating means for generating an electronic mail directed to the client's account (column 11, lines 21-29; outgoing e-mail), where the electronic mail has an attachment generated based on the received facsimile data (column 11, lines 21-29; "received fax message") received by said reception means (The FAX server 200 is the reception means for facsimile reception from FAX 110. In Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU Attachment". Further this goes as output of SMTP server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10,

lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments are processed for incoming emails which are converted to facsimile data.), and also based on the customized format of an image for the client received by said registration means (Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient. see also column 10, lines 23-31;); and

transmission means for transmitting the electronic mail generated by said generating means to the client's electronic mail account (column 11, lines 30-28). However Rachelson does not disclose wherein data includes color image information and/or monochrome image information

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64; color image is received at destination "PHOTOWORKS").

Having the system of **Rachelson '706** and then given the well-established teaching of **Blair et al '524**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Blair et al '524**, since **Blair et al '524** stated in pages 3-4, paragraph 30, such a modification would provide color image transmission to different selectable destinations as needed.

Regarding claim 10, Rachelson discloses a communication apparatus comprising:

registration means for registering electronic mail accounts of a plurality of clients (column 10, lines 23-31; "recipients " read on plurality of clients) via a first network upon receiving requests from each of the plurality of clients (column 8, lines 3-15; The address book is the registration means. The request occurs when e-mail is received from someone the first time.), wherein each of the requests includes a customized format of an image to be received (column 10, lines 21-31; see "recipient preferences" ; column 11, lines 21-29; Figure 2, the administrator 100 communicates over Internet);

reception means for receiving facsimile data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2);

management means for validating the registered electronic mail accounts (column 11, lines 12-18; column 8, lines 21-27; validation occurs when determination is made whether the recipient is new or not (ever received email).) and generating electronic mails for the validated electronic mail accounts (column 11, lines 21-29; column 8, lines 26-27; column 2, lines 33-42) where the electronic mail has an attachment generated based on the received facsimile data received by said reception means (The FAX server 200 is the reception means for facsimile reception from FAX 110. In Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it

clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU Attachment". Further this goes as output of SMTP server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10, lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments are processed for incoming emails which are converted to facsimile data.), **and also based on the customized format of an image for each of the plurality of clients received by said registration means** (Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient. see also column 10, lines 23-31;) ; and

transmission means for transmitting the generated electronic mails to each of the clients' electronic accounts validated by said management means (column 11, lines 30-28; column 8, lines 26-27; column 2, lines 33-42). However Rachelson does not disclose data which includes color image information and/or monochrome image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64; color image is received at destination "PHOTOWORKS").

Having the system of **Rachelson '706** and then given the well-established teaching of **Blair et al '524**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Blair et al '524**, since **Blair et al '524** stated in pages 3-4, paragraph 30, such a modification would provide color image transmission to different selectable destinations as needed.

Regarding claim 2, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein said generating means attaches an image received by said reception means to the electronic mail (column 11, lines 21-29; column 10, lines 40-49).

Regarding claim 7, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on an encoding system of said attached image (column 11, lines 25-29).

Regarding claim 8, Rachelson in view of Blair et al teach all the limitations of claim 1. Further Blair et al discloses the communication apparatus according to claim 1, wherein said reception means receives the color and/or monochrome image information based on a facsimile procedure (page 5, paragraph 48, page 6-7, paragraph 64; page 4, paragraph 30, lines 5-7).

Regarding claim 13, Rachelson in view of Blair et al teach all the limitations of claim 10. Further Rachelson discloses the communication apparatus according to claim 10, wherein said management means is capable of managing a plurality of electronic mail accounts registered at said registration means (column 8, lines 15-28; Figure 9a).

Regarding claim 16, see Rejection of claim 1 as shown above.

Regarding claim 18, see Rejection of claim 1 as shown above.

Regarding claim 17, see Rejection of claim 10 as shown above.

Regarding claim 19, see Rejection of claim 10 as shown above.

3. Claims 5, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 5, Rachelson in view of Blair et al teach all the limitations of claim 1. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail.

Shimoosawa '456 discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail (column 5, lines 13-20).

Having the system of *Rachelson '706 in view of Blair et al '524* and then given the well-established teaching of *Shimoosawa '456*, it would have been obvious to one

of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524*** as taught by ***Shimoosawa '456***, since ***Shimoosawa '456*** stated in Figure 4, and column 5, lines 13-29, such a modification would provide destination based processing of received data.

Regarding claim 12, ***Rachelson '706 in view of Blair et al '524*** teach all the limitations of claim 10. Further ***Shimoosawa '456*** discloses the communication apparatus according to claim 10, wherein said management means manages whether to transmit only text (column 8, lines 50-61), transmit only attachment file (column 10, lines 55-67) or transmit both the text and the attachment file of the received data (column 9, lines 62-67; column 10, lines 1-16).

Regarding claim 14, ***Rachelson '706 in view of Blair et al '524*** further in view of ***Shimoosawa*** teach all the limitations of claim 10. Further ***Shimoosawa*** disclose the communication apparatus according to claim 10, wherein said management means manages whether or not one of the registered email accounts is a mobile terminal (***Shimoosawa*** discloses that mobile PDA can be used as recipient of email data (column 1, lines 24-29; column 8, lines 48-55; column 9, lines 1-13)).

Regarding claim 15, ***Rachelson*** in view of ***Blair et al*** further in view of ***Shimoosawa*** teach all the limitations of claim 14. Further ***Shimoosawa*** disclose the communication apparatus according to claim 14, wherein said management means manages the setting in case of forwarding an electronic mail to the mobile terminal (***Shimoosawa*** teaches that when transferring data to mobiles like PDA, the attachments

can be excluded from the data sent to prevent the PDAs from becoming memory full (column 8, lines 48-67).).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Rachelson in view of Blair et al teach all the limitations of claim 1. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54).).

Having the system of ***Rachelson '706 in view of Blair et al '524*** and then given the well-established teaching of ***Blossman et al '783***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524*** as taught by ***Blossman et al '783***, since ***Blossman et al '783*** stated in column 4, lines 38-41, such a modification

would provide a destination specific transmission of important documents based on preference of users.

5. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 9, Rachelson in view of Blair et al teaches all the limitations of claim 8. However Rachelson in view of Blair et al does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al '016 disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Having the system of ***Rachelson '706 in view of Blair et al '524*** and then given the well-established teaching of ***Fujii et al '016***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524*** as taught by ***Fujii et al '016***, since ***Fujii et al '016*** stated in column 1, lines 20-23, such a modification would provide image transmission through email using ITU-T T.37 standard which is required.

Regarding claim 11, Rachelson '706 in view of Blair et al '524 teaches all the limitations of claim 10. Further Fujii et al '016 disclose the communication apparatus according to claim 10, wherein said reception means executes a reception process

based on the ITU-T T. 37 recommendation (column 1, lines 13-24; "transmit and receive").

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6356356 to Miller, Jr et al.

Regarding claim 20, Rachelson '706 in view of Blair et al '524 teaches all the limitations of claim 1. Rachelson '706 does disclose transmission of electronic mail based on information registered at said registration means (column 8, lines 4-14, 21-29; the address book is the registration means which registers information (email address)). However Rachelson '706 in view of Blair et al '524 does not disclose the communication apparatus according to claim 1, wherein said transmission transmits the electronic mail generated by said generating means to a plurality of clients based on information.

Miller, Jr et al '356 discloses transmits the electronic mail generated by said generating means to a plurality of clients based on information (column 5, lines 54-67; column 6, lines 1-8; "more than one destination" reads on plurality of clients; the information stored in step 46 is the information used for transmission to plurality of clients.).

Having the system of *Rachelson '706 in view of Blair et al '524* and then given the well-established teaching of *Miller, Jr et al '356*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *'706 in view of Blair et al '524* as taught by *Miller, Jr et al '356*, since *Miller, Jr et al '356* stated in col. 4, lines 43-55, such a modification would provide "broadcasting" capabilities for facsimile to email transmission.

Regarding claim 21, see rejection of claim 20 as shown above.

Regarding claim 22, see rejection of claim 20 as shown above.

Other Prior Art Cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication No. US2005/0219640 A1 to Kasatani discloses communication with multifunction device.

U.S. Patent Application Publication No. US2006/0072144 A1 to Dowling et al discloses scanner system.

U.S. Patent Application Publication No. US2007/0236732 A1 to Henry discloses facsimile communication system.

U.S. Patent Application Publication No. US2007/0236749 A1 to Henry et al discloses facsimile communication with formatting.

U.S. Patent Application Publication No. US2007/0236750 A1 to Henry et al
discloses facsimile/email system.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

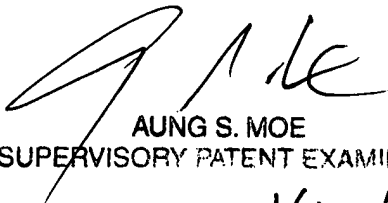
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Patent Examiner

Beniyam Menberu

BM

01/19/2008


AUNG S. MOE
SUPERVISORY PATENT EXAMINER

1/19/08